



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Hideki MATSUNAGA

Group Art Unit: 2162

Application No.: 09/923,440

Examiner: A. LY

Filed: August 8, 2001

Docket No.: 110331

For: OBJECT MANAGEMENT METHOD AND SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

A Notice of Appeal and Petition for Extension of Time are attached. Applicant respectfully requests review of the Final Rejection mailed on October 13, 2006 regarding the above-identified application in light of the following remarks.

Claims 1-18 are pending in this application. The Office Action rejects claims 1 and 10 under 35 U.S.C. §112, second paragraph. This rejection is respectfully traversed.

The Office Action asserts that it is not clear what the retrieval condition, attribute of the object and identifier for identifying the object recited in the claims are. These terms are adequately described in the Applicant's specification as filed (see, e.g., pages 2, 3, 7, 8 and 13 and Figs. 2, 3, 7 and 8). Further, the terms are not inherently vague or indefinite. Rather, these terms are capable of understanding based on standard claim construction.

Accordingly, reconsideration and withdrawal of the rejection of claims 1 and 10 under 35 U.S.C. §112, second paragraph, are respectfully requested.

The Office Action rejects claims 1 and 10 under 35 U.S.C. §101 as lacking a useful tangible result. This rejection is respectfully traversed.

Claims 1 and 10 positively recite performing access control in response to an access request. The access request can be directed to a variety of objectives that are achieved or denied via the access control (see, e.g., page 6, lines 18-20 and pages 9-12). Performing access control, in response to an access request, for an object matching a retrieval condition and an identifier on the basis of an access right as recited in the pending claims constitutes a tangible, real world result.

Accordingly, reconsideration and withdrawal of the rejection of claims 1 and 10 under 35 U.S.C. §101 are respectfully requested.

The Office Action rejects claims 1-18 under 35 U.S.C. §103(a) over U.S. Patent Application Publication No. 2002/012085 to Porter et al. (hereinafter "Porter") in view of U.S. Patent Application Publication No. 2000/0199765 to Kohane et al. (hereinafter "Kohane"). This rejection is respectfully traversed.

Porter does not teach, nor can it reasonably be considered to have suggested, all of the features attributed to it by the Office Action. Further, the combination of Porter and Kohane is unreasonable.

The Office Action asserts that Porter teaches a method comprising, among other features, a step of setting an access right as recited in the pending claims. However, Porter does not teach, nor can it reasonably be considered to have suggested, a combination of features corresponding to those positively recited in the pending claims. For example, access control to stored documents in Porter is based on access rights assigned to the document not access rights set in association with a retrieval condition.

Claim 1 recites, among other features, defining a retrieval condition for retrieving an object, the retrieval condition being defined based on at least one attribute of the object, and

setting an access right in association with the retrieval condition. Claim 10 recites similar features. Aspects of an embodiment of such features are depicted in Fig. 2.

Porter teaches a retrieval condition being used to identify one or more documents. The user's access to each of these documents in Porter is then individually verified by a separate security subroutine (see paragraph [0083] of Porter). The security subroutine references the access rights of the document, which were set when the document was created, against an access control entry/list (see paragraph [0075]). As such, the access right to any given document is set before the retrieval condition is set. Therefore, it cannot reasonably be considered that the access right in Porter is set in association with the retrieval condition. The access right is set by the document creator, irrespective of any future retrieval condition.

Further, the Office Action has not provided sufficient motivation for combining Porter and Kohane. The Office Action concedes that Porter does not teach performing access control, in response to a request, for the object matching retrieval condition and identifier on the basis of the access right. The Office Action then asserts that "[o]ne having ordinary skill in the art would have found it motivated to utilize the use of controlling access to data objects on the Internet, thereby helping the object owner having authorized to access his/her own the object over the Internet."

The conclusory statements regarding obviousness to combine Porter and Kohane do not meet the articulated standard for proving that there is a teaching, suggestion or motivation in the prior art to combine these references in the manner suggested by the Office Action. The Federal Circuit recently reaffirmed its prior holdings asserting that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, Appeal No. 04-1616, March 22, 2006 (Fed. Cir.)

(quoting *In re Lee*, 277 F.3d 1338, 1343-46 (Fed. Cir. 2002), and *In re Rouffet*, 149 F.3d 1350, 1355-59 (Fed. Cir. 1998)). This standard is not met here.

MPEP §2143.01 instructs that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP §2143.01 further instructs that "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" See also *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Applicant respectfully submits that the rejection of at least independent claims 1 and 10 is improper in view of at least MPEP §2143.01 because the Office Action lacks the required specific objective evidence of a teaching, suggestion or motivation in the prior art for one of ordinary skill to combine these references in the manner suggested.

For at least these reasons, the applied prior art references are not combinable in the manner suggested, and any permissible combination of the applied prior art references cannot reasonably be considered to teach, or to have suggested, the combinations of all of the features positively recited in independent claims 1 and 10. Additionally, claims 2-9 and 11-18 are also neither taught, nor would they have been suggested, by the applied prior art references for at least the respective dependence of these claims, directly or indirectly, on allowable independent claims 1 and 10, as well as for the separately patentable subject matter that each of these claims recites.

In view of the foregoing, Applicants respectfully request that the Review Panel review the substance of the October 13, 2006 Final Rejection. Applicant believes that upon such review, the Review Panel will determine that a *prima facie* case for obviousness of the subject matter of the pending claims over the applied prior art references has not been

established and that the claims are definite and recite tangible, real-world results. In this regard, favorable reconsideration and prompt allowance of claims 1-18 are earnestly solicited.

Should the Review Panel believe that anything further will be desirable in order to place this application in even better condition for allowance, the Review Panel is invited to contact Applicant's undersigned representative.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

James E. Golladay, II
Registration No. 58,182

JAO:JEG/hms

Date: February 13, 2007

Attachment:

Notice of Appeal and Petition for Extension of Time

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

| |
|--|
| DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461 |
|--|